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To: Commissioner for Patents for **Examiner Viet Duy Vu** **Group Art Unit 2154**	Facsimile No.: **703/872-9306**
From: Michele Morrow Legal Assistant to Gerald H. Glanzman	No. of Pages Including Cover Sheet: 26

Message:

Enclosed herewith:

- Transmittal Document; and
- Appeal Brief.

Re: Application No. 09/671,059

Attorney Docket No: AUS9-2000-0496-US1

Date: Friday, December 10, 2004

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Kabik et al.**	§	Group Art Unit: **2154**
	§	
Serial No.: 09/671,059	§	Examiner: **Vu, Viet Duy**
	§	
Filed: September 28, 2000	§	Attorney Docket No.: AUS9-2000-0496-US1
	§	
For: **Method and Apparatus for**	§	
Adding Data Attributes to E-Mail	§	
Messages to Enhance the Analysis of	§	
Delivery Failures	§	

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By: *Michele Morrow*
Michele Morrow

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Commissioner for Patents
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- Appeal Brief (37 C.F.R. 41.37).

A fee of $500.00 is required for filing an Appeal Brief. Please charge this fee to IBM Corporation Deposit Account No. 09-0447. No additional fees are believed to be necessary. If, however, any additional fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0447. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0447.

Respectfully submitted,

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Docket No. AUS9-2000-0496-US1   *PATENT*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Kubik et al.**	§	
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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF (37 C.F.R. 41.37)

This brief is in furtherance of the Notice of Appeal, filed in this case on October 15, 2004.

The fees required under § 41.20(B)(2), and any required petition for extension of time for filing this brief and fees therefore, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

REAL PARTY IN INTEREST

The real party in interest in this appeal is the following party: International Business Machines Corporation.

RELATED APPEALS AND INTERFERENCES

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal, there are no such appeals or interferences.

STATUS OF CLAIMS

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are: 1-30

B. STATUS OF ALL THE CLAIMS IN APPLICATION

1. Claims canceled: NONE
2. Claims withdrawn from consideration but not canceled: NONE
3. Claims pending: 1-30
4. Claims allowed: NONE
5. Claims rejected: 1-30

C. CLAIMS ON APPEAL

The claims on appeal are: 1-30

STATUS OF AMENDMENTS

An Amendment after Final Rejection was not filed. Therefore, claims 1-30 on appeal herein are as amended in the Response to Office Action filed March 3, 2004.

(Appeal Brief Page 5 of 24)
Kubik et al. – 09/671,059

PAGE 7/26 * RCVD AT 12/10/2004 11:10:17 AM [Eastern Standard Time] * SVR:USPTO-EFXRF-1/0 * DNIS:8729306 * CSID:9723857766 * DURATION (mm-ss):05-52

SUMMARY OF CLAIMED SUBJECT MATTER

A.   CLAIM 1 - INDEPENDENT

The present invention relates to a technique for enabling dead E-mail addresses to be identified without having to send actual messages to the addresses. The subject matter recited in claim 1 is directed to a method illustrated in **Figures 9A-9C** and **10** and is described beginning on page 21, line 22 and extending to page 25, line 3. The method recited in claim 1 begins by creating an electronic message having a recipient at an address on a server (see page 23, lines 16-17, Step 952 in **Figure 9B**). The electronic message includes at least one delivery value attribute identifier for identifying at least one delivery attribute (see page 23, lines 17-20, Step 954 in **Figure 9B**; additionally, a process of setting an attribute value is described on page 23, line 22 to page 23, line 2 and is illustrated in **Figure 9C**). The created electronic message is then sent to the recipient (see page 21, lines 27-28, Step 904 in **Figure 9A**), and a response is received (see page 21, lines 31-32, Step 906 in **Figure 9A**).

The response includes validity information indicating whether the address is a valid address and at least one delivery attribute value that corresponds to the at least one delivery attribute. The at least one delivery attribute value includes delivery information regarding the electronic message (see page 24, line 3-page 25, line 3, **Figure 10**).

As described, for example, on page 25, lines 18-24, using the delivery attributes enables analysis of e-mail message delivery failures to be enhanced by permitting the location of a failure to be pinpointed and to permit profiling the performance of routing of messages and other details.

B.   CLAIM 11 – INDEPENDENT

The subject matter of claim 11 is directed to a method in which an electronic message having a recipient at an address on a server is received (see page 21, lines 31-32, Step 906 in **Figure 9A**), and at least one delivery attribute identifier in the electronic message is identified for identifying at least one delivery attribute. A response is then generated that includes validity information indicating whether the address is a valid address and at least one delivery attribute value that corresponds to the at least one delivery attribute. The at least one delivery attribute

value includes delivery information regarding the electronic message(see page 24, line 3- page 25, line 3, **Figure 10**).

C. CLAIM 15 – INDEPENDENT

Independent claim 15 is an apparatus claim, and the subject matter of the claim is, substantially, an apparatus claim counterpart to method claim 1.

D. CLAIM 25 – INDEPENDENT

Independent claim 25 is an apparatus claim, and the subject matter of the claim is, substantially, an apparatus claim counterpart to method claim 11.

E. CLAIM 29 - INDEPENDENT

Independent claim 25 is a computer program product claim, and the subject matter of the claim is, substantially, a computer program product claim counterpart to method claim 1.

F. CLAIM 30 - INDEPENDENT

Independent claim 30 is a computer program product claim, and the subject matter of the claim is, substantially, a computer program product claim counterpart to method claim 11.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

GROUND OF REJECTION (Claims 1-30)

Claims 1-30 stand rejected under 35 U.S.C. § 102(e) as anticipated by Rollins (U.S. Patent No. 6,434, 601).

ARGUMENT

A.   GROUND OF REJECTION (Claims 1-30)

A1.   Claims 1-10, 15-24 and 29

Rollins is directed to a technique for testing the address to which an e-mail message is to
be sent during typing of the message and before an attempt is actually made to send the message.
In Rollins, during the typing of an e-mail message, the existence of both the server and the
addressee that are specified in the "To" field of the message are checked before the message is
sent. If the server or the addressee does not exist, the patent suggests that the addressee's Internet
e-mail address has been incorrectly typed, and the author of the message is so informed.

A primary purpose of the system in Rollins is to advise the author of an e-mail message
of an error in entering an intended recipient's e-mail address before the message is futilely sent
so that the error can be corrected.

In rejecting the claims, the Examiner states as follows:

Rollins discloses a pretest email system comprising:
a) means for creating a pretest message including a ping and/or a test message,
   the pretest message having at least one delivery attribute including server
   address and/or recipient address (see col. 5, lines 31-44 and col. 6, lines 1-10),
b) means for sending the message to the recipient,
c) means for receiving a response including validity information indicating
   whether the address is valid (see col. 5, lines 45-60 and col. 6, lines 11-27),
d) means for processing the delivery attribute value to form a failure analysis
   information and presenting the failure analysis information to the user (see
   col. 6, lines 28-39).

Office Action dated January 14, 2004, pages 3-4.

Claim 1 of the present application reads as follows:

1.   A method comprising:
        creating an electronic message having a recipient at an address on a server,
wherein the electronic message includes at least one delivery attribute identifier
for identifying at least one delivery attribute;
        sending the electronic message to the recipient; and

receiving a response, the response including validity information indicating whether the address is a valid address, and at least one delivery attribute value corresponding to the at least one delivery attribute, the at least one delivery attribute value including delivery information regarding the electronic message.

Appellants submit that Rollins does not disclose "creating an electronic message having a recipient at an address on a server, wherein the electronic message includes at least one delivery attribute identifier for identifying at least one delivery attribute" as required by claim 1; and, in addition, does not disclose "receiving a response, the response including validity information indicating whether the address is a valid address, and at least one delivery attribute value corresponding to the at least one delivery attribute, the at least one delivery attribute value including delivery information regarding the electronic message" (emphasis added).

In Rollins, when a cursor is moved from the "To" field to the "Subject" field during typing of an e-mail message, the e-mail program sends out a ping to the server specified in the "To" field to verify the existence of the server. As stated in column 4, lines 2-17 of Rollins:

> ...If the specified mail server does respond to the ping, it is an affirmative response which signals to the user's e-mail program the existence of the recipient's mail server (e.g."host"), at step S22. In the case of such an affirmative response, the user is not notified (i.e., the pre test operates completely in the background).
>
> If the specified mail server does not respond to the ping (i.e., if the ping "times out" without a response), it likely means that there is an error with the mail server portion of the specified e-mail address (i.e., an error in the way in which it was typed into the "To" field of the user's e-mail program). If such is the case, the program will return an error message at step S24. The error message will inform the user of the unknown host, giving the user an opportunity to correct the fatal error before the message is futilely sent.

When the user moves the cursor from the "Subject" field to the "Message" field during typing of the e-mail message, a test message is generated and sent to the same mail server to verify the existence of the addressee specified in the "To" field as a user on the mail server. As stated in column 4, lines 44-59 of Rollins:

(Appeal Brief Page 10 of 24)
Kubik et al. – 09/671,059

PAGE 12/26 * RCVD AT 12/10/2004 11:10:17 AM [Eastern Standard Time] * SVR:USPTO-EFXRF-1/0 * DNIS:8729306 * CSID:9723857766 * DURATION (mm-ss):05-52

Next, depending upon the response it receives from the addressee's mail
server, the present invention determines whether the addressee does exist as a user
on the addressee's mail server at step S30. The addressee's mail server, having
standard configuration, will respond to the small test message in either the
affirmative or the negative. If the response is in the negative, the user's e-mail
program generates an error message, at step S32, prompting the user to check the
accuracy of the username (e.g., spelling, etc.) which is currently in the "To" field
with a valid host name.

If the response from the addressee's mail server is in the affirmative (i.e.,
the username exists on the addressee's mail server), the addressee's mail server
responds to the small test message with a message header, thereby confirming
receipt of the small test message to the user's e-mail program at step S34.

Thus, in Rollins, during testing of the existence of both the mail server and the addressee
specified in the addressee's Internet e-mail address, the specified mail server simply responds to
the test message in either the affirmative or the negative (or does not respond at all in the case
that the mail server has been incorrectly identified). In Rollins, accordingly, the response
includes only information indicating whether an address is a valid address. The electronic
message to be sent does not include "at least one delivery attribute identifier for identifying at
least one delivery attribute" as recited in claim 1, and the response does not include, in addition
to validity information, "at least one delivery attribute value corresponding to the at least one
delivery attribute, the at least one delivery attribute value including delivery information
regarding the electronic message" as also recited in claim 1. Accordingly, Rollins does not
disclose the subject matter of claim 1 and cannot anticipate claim 1.

In the Final Office Action, the Examiner responds to Appellants' arguments as follows:

> Applicant alleges that Rollins does not teach receiving the response
> containing both validity information and one delivery attribute value.
> This is not found persuasive. It is submitted that in Rollins the response contains
> two parts: a message header containing delivery attribute identifier for identifying
> delivery attribute value such as mail sender/recipient server addresses and a
> message containing validity information indicating whether the address is a valid
> address (see col 4, lines 54-59).

Final Office Action dated September 16, 2004, page 2.

Col. 4, lines 54-59 of Rollins referred to by the Examiner reads as follows:

> If the response from the addressee's mail server is in the affirmative (i.e., the username exists on the addressee's mail server), the addressee's mail server responds to the small test message with a message header, thereby confirming receipt of the small test message to the user's e-mail program at step S34.

Nowhere in this paragraph is it disclosed that an electronic message is created that has a recipient at an address on a server, "wherein the electronic message includes at least one delivery attribute identifier for identifying at least one delivery attribute", and that a response is received that includes both "validity information indicating whether the address is a valid address", and "at least one delivery attribute value corresponding to the at least one delivery attribute, the at least one delivery attribute value including delivery information regarding the electronic message". In Rollins, as indicated above, an affirmative response is sent by a server specified in the "To" field of an e-mail message if the server exists. The server then responds to a small test message "in either the affirmative or the negative" as to whether the addressee specified in the "To" field exists on the server (col. 4, lines 44-49 of Rollins). There is no disclosure that a server response in Rollins includes "at least one delivery attribute value corresponding to the at least one delivery attribute" that was sent to the server. As discussed above, in Rollins, the server responds only with validity information indicating whether the address is a valid address.

For at least all the above reasons, Rollins does not anticipate claim 1, and claim 1 should be allowable over Rollins in its present form.

Claims 2-10 depend from and further restrict claim 1, and are also not anticipated by Rollins, at least by virtue of their dependency. Furthermore, many of these claims recite additional features that are not taught by Rollins. For example, claim 2 depends from claim 1 and recites that the at least one delivery attribute identifier comprises at least one of a recipient mail system identifier, a recipient mail server identifier, a recipient router identifier, a sender mail system identifier, a sender mail server identifier and a sender router identifier. Claim 4 depends from claim 3 and specifies that the at least one delivery attribute value comprises an address including at least one of a recipient mail system address, a recipient mail server address, a recipient router address, a sender mail system address, a sender mail server address and a sender

router address. Rollins does not disclose the subject matter of these claims, and claims 2 and 4 should be allowable in their own right as well as by virtue of their dependency.

Claim 3 depends from claim 1 and reads as follows:

3. The method of claim 1, wherein the validity information indicates that the address is an invalid address, the method further comprising:
    processing the at least one delivery attribute value to form delivery failure analysis information; and
    presenting the delivery failure analysis information.

The Examiner refers to column 6, lines 28-39 of Rollins as disclosing the subject matter of claim 3. Appellants respectfully disagree. Column 6, lines 28-39 of Rollins reads as follows:

If, however, C_1's user has typed in an incorrect addressee (i.e., on the now verified existing server 208), server 208 responds to the test message in the negative. That is, the server's 208 response to C_1 indicates that the addressee (as typed) does not exist as a user on server 208. The negative response to the test message follows a path back to C_1 which is substantially the same as a path followed by the server's 208 response to the ping. Upon receiving the negative response from server 208, C_1 then notifies the user of the e-mail program that there is an error with the address as types in the "To" field, prompting the user to correct the error before the actual message is sent in vain.

In Rollins, as indicated above, a response only indicates whether or not the addressee exists. There is no delivery attribute value in the response. Accordingly, Rollins does not process at least one delivery attribute value to form delivery analysis failure information, as recited in claim 3. Claim 3, accordingly, is also believed to be allowable over Rollins in its own right as well as by virtue of its dependency from claim 1.

Independent claims 15 and 29 are, respectively, apparatus claim and computer program product claim counterparts to method claim 1, and are not anticipated by Rollins for substantially the same reasons as discussed above with respect to claim 1. Claims 16-24 depend from and further restrict independent claim 15, and are also not anticipated by Rollins, at least by virtue of their dependency.

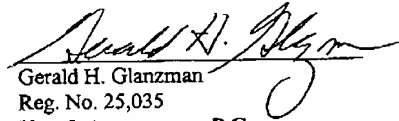## A2.   Claims 11-14, 25-28 and 30

Independent claim 11 is as follows:

11.   A method comprising:
    receiving an electronic message having a recipient at an.address on a
server;
    identifying at least one delivery attribute identifier in the electronic
message for identifying at least one delivery attribute; and
    generating a response, the response including validity information
indicating whether the address is a valid address, and at least one delivery
attribute value corresponding to the at least one delivery attribute, the at least one
delivery attribute value including delivery information regarding the electronic
message.

For substantially the same reasons as discussed in detail above with respect to claim 1,
Rollins does not disclose "identifying at least one delivery attribute identifier in the electronic
message for identifying at least one delivery attribute" as recited in claim 11, and does not
disclose "generating a response, the response including validity information indicating whether
the address is a valid address, and at least one delivery attribute value corresponding to the at
least one delivery attribute, the at least one delivery attribute value including delivery
information regarding the electronic message" as also recited in claim 11. Claim 11, accordingly,
is also not anticipated by Rollins and should be allowable over Rollins in its present form.

Claims 12-14 depend from and further restrict claim 11, and are also not anticipated by
Rollins, at least by virtue of their dependency. Independent claims 25 and 30 are, respectively,
apparatus claim and computer program product claim counterparts to method claim 11, and are
not anticipated by Rollins for substantially the same reasons as discussed above with respect to
claim 11. Claims 26-28 depend from and further restrict claim 25, and are also not anticipated by
Rollins, at least by virtue of their dependency.

Therefore, claims 1-30 are believed to patentably distinguish over Rollins, and it is respectfully requested that the Board reverse the Examiner's Final Rejection of the claims.

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(Appeal Brief Page 15 of 24)
Kubik et al. — 09/671,059